

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Oliver SCHADT et al.

Serial No.: 10/552,064

Group Art Unit: 1624

Filed: October 5, 2005

Examiner: JARRELL, Noble E.

Title: SUBSTITUTED PYRAZOLE COMPOUNDS

PETITION OF THE RESTRICTION REQUIREMENT UNDER 37 C.F.R. §1.181

TECHNOLOGY CENTER 1600

Commissioner for Patents

P.O. Box 1450

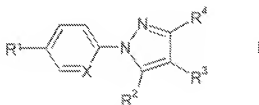
Alexandria, VA 22313-1450

Sir:

This is a petition requesting the Commissioner, through the Honorable Group Director, to reverse the Examiner's decision in instituting a Restriction within a single claim and denying extension of the search beyond the elected invention.

Statement of Facts

On March 14, 2007, an Office Action, made an election restriction requirement and named 140 groups. The products, i.e., claimed compounds, were restricted into 35 groups. Group III, which was elected with traverse in the Reply filed on April 3, 2007, was defined in said Office Action as compounds of formula I



wherein variables X, R², and one of R³/R⁴ are defined as C, C_{0.5}-Furan, and C_{0.5}-Piperazine, respectively. The other one of R³/R⁴ is H as recited in claim 1. A species election was also made. Applicants elected with traverse compound 8 of example 7 (see page 29 of specification).

Reconsideration of the Restriction was requested, e.g., in the Response filed August 7, 2007.

Argument in Support of Reversal of Denial to Extend the Search

In support of the restriction requirement the Office Action dated March 14, 2007, cited WO2001032627, identified therein a structure 24, which is reproduced in said Office Action, as allegedly anticipating the claims, and thus, providing support for the allegation that there is no unity of invention.

However, said structure did not at any one time anticipate any of the claims of the present invention. For example, the corresponding group in said structure to applicants R⁴ is methyl (which is also explicitly admitted by the Office Action). However, R⁴ cannot be methyl in the claims. See, e.g., original claim 1. Also, the corresponding group in said structure to applicants' X, R¹ and R² groups are C, H and phenyl, in the order recited. However, such is not a possible combination for these groups in the claims. See in the definition of X the options for R¹ and R² when X can be C. Thus, there are several differences between the claimed invention and the allegedly anticipating compound which allegedly served as the basis for the allegation that the special technical feature linking the claims does not provide a contribution over the art.

For this reason alone, the restriction requirement should be withdrawn.

Moreover, the claims here are Markush claims. MPEP §803, entitled "Restriction - When Proper," states that "[i]nsofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria are set forth in MPEP §803.02." The latter section of the MPEP states that: "[s]ince the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), **it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention.**" (emphasis added)

Thereafter, the MPEP cites *In re Harnish*, 206 USPQ 300 (CCPA 1980) and *Ex parte Hozumi*, 3 USPQ2d (Bd. Pat. App. & Int. 1984). These two cases both deal with improper Markush rejections. Thus, in the case of Markush claims, refusal by the Office to examine that which the applicants regard as their invention must be a refusal based on an improper Markush rejection.

Despite the explicit instructions set forth in the MPEP, the Examiner here is clearly seeking to make a Restriction within a claim. Applicants respectfully submit that 35 USC §121 does not permit restriction within a single claim as clearly indicated by the court in *In re Weber*

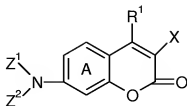
et al., 198 USPQ 328 (1978).

As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits.

It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions when those inventions are found to be “independent and distinct.” It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular claim on that same basis. [*Weber* at 331-332]

The effect of restriction within a single claim is the same as a rejection. 35 USC §121 does not give the Commissioner authority to require that a single claim “be divided up and presented in several applications” and thus deny the Applicant the right to have that single claim considered on its merits. This is exactly the action that the Court in *Weber* stated was not permitted under 35 USC §121. Such action by an Examiner would violate “the basic right of the Applicant to claim his invention as he chooses.” [*Weber* at 332]

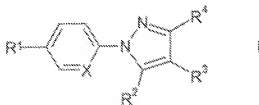
Further, in the instant case, even if the Examiner had asserted that the subject matter of claim 1 lacked “unity of invention,” and therefore should be restricted on grounds of an improper Markush rejection, it is clear that applicants' claims recite a proper Markush grouping. In this regard, the decision in *In re Harnisch*, 206 USPQ 300 (CCPA 1980) is relevant. In *Harnisch*, the claimed genus of compounds was defined by the following formula:



alkyl, cycloalkyl, or a 2- or 3-membered alkylene radical connected to the 8-position of the coumarin ring. In addition, Z¹ and Z² together with the nitrogen atom could represent an optionally benz-fused heterocyclic ring which "like ring A and the alkyl, aralkyl, cycloalkyl, and aryl radicals mentioned, can carry further radicals customary in dye-stuff chemistry."

Thus, as can be seen, the definition of Z¹ and Z² encompassed a very wide variety of structures including various nitrogen containing heterocyclic structures such as morpholiny, piperidyl, piperazinyl, etc. Yet, the Court in *Harnisch* reversed the improper Markush rejection noting that the claimed compounds were dyes and that the subgenus claimed was not repugnant to scientific classification.

In the instant case, the compounds of applicants, claimed genus are substituted pyrazole compounds, which are suitable as ligands of 5HT receptors, and are thus useful, e.g., for treating a variety of central nervous diseases. The compounds of the claimed genus all contain the following significant unchanging core structure of formula I:



Compare the core structure of the genus in *Harnisch*. No rationale is presented in the Office Actions as to why applicants' claimed genus of compounds, with its significant core structure and common activity, would be repugnant to scientific classification.

Furthermore, the Office Action has not established that it would pose an undue burden to examine the entire scope of the claimed invention. Instead a very narrow definition is chosen for several substituents effectively restricting the claims to a very narrow group (one of thirty product groups), for which restriction no proper basis is provided.

Conclusion

For the forgoing reasons, Applicants request reversal of the Examiner's decision to maintain the Restriction Requirement and that examination proceed in accordance with the MPEP sections cited above.

In this respect applicants respectfully request that the examination proceed first with the compounds where X is N.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

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